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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/531,573 | 04/18/2005 | Robert Reinhard | 3165-120 | 1876 |

6449 7590 03/27/2007
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
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SUITE 800
WASHINGTON, DC 20005

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| EXAMINER |
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GRAZIER, NYEEMAH

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| ART UNIT | PAPER NUMBER |
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1626

| SHORTENED STATUTORY PERIOD OF RESPONSE | NOTIFICATION DATE | DELIVERY MODE |
|--|-------------------|---------------|
| 3 MONTHS | 03/27/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/531,573 | Applicant(s) REINHARD ET AL. | |
| | Examiner Nyeemah Grazier | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18, 19 and 21-25 is/are rejected.
- 7) ☒ Claim(s) 17 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
FIRST ACTION ON THE MERITS

I. ACTION SUMMARY

Claims 1-25 are currently pending. Claims 13-16 have been withdrawn as said drawn to non-elected subject matter. The claims may be rejoined commensurate in scope with the allowed product claims.

II. PRIORITY

This application is a 371 of PCT/EP03/11557, filed October 17, 2003 and claims benefit under 35 U.S.C. 119(a-d) to foreign application GERMANY 10248700.6, filed October 18, 2002.

III. INFORMATION DISCLOSURE STATEMENT

The information disclosure statement (IDS) submitted on April 18, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

IV. RESTRICTION/ELECTION

Election: Applicant's Response

Applicant's election of Group IV, in the response filed on February 5, 2007 is acknowledged.

The applicant traverses on the grounds that the unity of invention is not lacking as the instant invention has contribution over the art cited in the Lack of Unity Action.

Applicant also requested that the restriction is vacated.

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The traversal is on the ground(s) that unity of invention is not lacking is not persuasive. This is not found persuasive because the art cited (WO 90/07500 A1) and the instant invention are both drawn to herbicides and the art of record renders the instant invention obvious despite the fact that R3 is an alkyl group.

However, upon further consideration the Examiner has rejoined certain groups and define the scope of the invention for purposes of examination.

Groups I-III, and V-VIII have been rejoined. Thus, the scope of the elected subject matter are the compounds of Formula (I) of claims 1-12 and 17-21, wherein X and Y are oxygen. All other variables have the original definitions in claim 1.

The requirement is still deemed proper and is therefore made FINAL.

V. REJECTION(S)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Graham v. John Deere Co. set forth the factual inquiries necessary to determine obviousness under 35 U.S.C. § 103(a). See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Specifically, the analysis must employ the following factual inquiries:

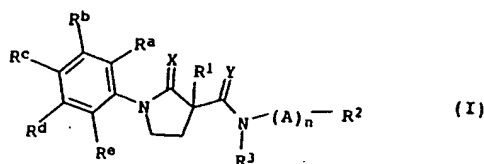
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12, and 18, 19, 21-25 are rejected under 35 U.S.C. § 103(a) as being obvious over *WO 90/07500 (ICI Americas Inc.)* equivalent – U.S. 4,874,422.

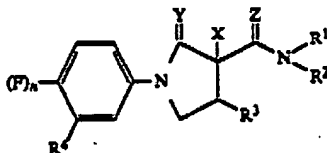
The instant invention is drawn to the compounds and composition of formula (I)



The instant invention is useful as herbicides.

The Scope and Content of the Prior Art (MPEP §2141.01)

WO 90/07500 A1 (U.S. 4,874,422) teaches compounds and compositions and methods of using the products as herbicides. The invention of the art of record is drawn to formula (I):



The Difference Between the Prior Art and the Claims (MPEP §2141.02)

The difference between the instant invention and the invention disclosed in 4,874,422 is that in the art of record, the preferred compounds require an alkyl substituent on the fourth position on phenyl-pyrrolidone and in the instant invention, the fourth position is unsubstituted.

Resolving Level of Ordinary Skill in the Pertinent Art

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The pertinent art is chemistry. One of ordinary skill in the pertinent art would have the motivation to make and use to instant invention because there is motivation to make in the instant compounds in the abovementioned references which teach compounds useful for herbicides. The motivation to make claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

Prima Facie Obviousness-The Rational and Motivation (MPEP §2142-2413)

It is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. In re Boe, 148 USPQ 507 (CCPA 1966). For an invention to be obvious, two things must be found in the prior art: 1) the suggestion of the invention, and 2) the expectation of success. In re Vaeck, 20 USPQ.2d 1438, 1441 (Fed. Cir. 1991).

The prima facie case for obviousness is derived from the preferred teaching of the references. The reference teaches preferred compounds and preferred variable substituents in the "Detailed Description of the Invention."

The preferred substitution on formula (I): R₄ is trifluoromethyl, n is zero, X is preferably hydrogen, and Y and Z are preferably oxygen. See col. 2, lines 35-38.

Furthermore, it is well established that the substitution of methyl for hydrogen on a known compound is not a patentable modification absent unexpected or unobvious results. In re Woods, 582 F.2d 638, 199 USPQ 137 (CCPA 1978).

VI. OBJECTION(S)

Claims 17 and 20 are objected to because said claims are dependent on a rejected based claim.

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VII. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

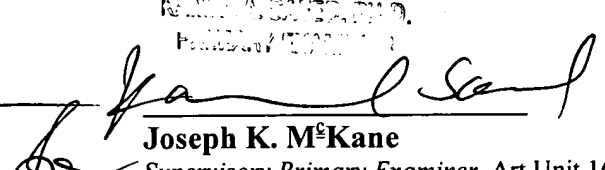
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. M^cKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,


Nyeemah Grazier, Esq.

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